REMARKS

Claims 13, 14, 16, and 17 are pending and under examination. The Office maintains its rejection of the pending claims under 35 U.S.C. § 102(b), as discussed below.

Priority Documents

As a preliminary matter, the Office has acknowledged receipt of the certified copies of priority documents JP 2004-021808 and JP 2003-282691. *See* Office Action, p. 2. On page 1 of the Office Action, however, the Office has not acknowledged Applicants' claim for foreign priority based on these documents. *See* Office Action, p. 1, item 12.

Applicants request that the Office acknowledge its claim to priority based on JP 2004-021808 and JP 2003-282691 in the next Office Action.

Rejection Under 35 U.S.C. § 102

The Office continues to reject claims 13, 14, 16, and 17 under 35 U.S.C. § 102(b) as allegedly anticipated by Urashima et al. (WO 97/13515; "Urashima"). *See* Office Action, page 2. According to the Office, Urashima "teaches the treatment of Sjogren's syndrome and 'dry eye' syndrome with administration of the elected compound." *Id.* Acknowledging that Urashima does not teach the effectiveness of the "elected compound to accelerate salivation," the Office nonetheless contends that the "claimed compound is expected to necessarily have the claimed effect on acceleration of salivation. . . . " *Id.* The Office reasons that "even if the acceleration of salivation was not itself recognized as a pharmacological effect of administering the elected compound, such an effect is not considered a therapeutic application because the

known treatment of Sjogren's syndrome is known in the prior art." *Id.* at 3. Applicants traverse.

In the response filed May 7, 2009, Applicants noted that the rejected claims described a "method for accelerating salivation" or a "method for treatment of xerostomia" comprising administering the recited carbostyril compound orally. The Office now asserts that Urashima teaches "administration of the identical compound in the exact manner as that claimed." Office Action, p. 3. Urashima's disclosure focuses on the treatment of dry eye. Thus, Urashima's teaching of oral administration of the carbostyril compound is presented in the context of treating dry eye. As Applicants discuss below, the attached Declaration by Dr. Hisashi Nagamoto demonstrates that oral administration of the carbostyril compound recited in independent claims 16 and 17 does not successfully treat dry eye.

As the M.P.E.P. instructs, "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is *necessarily present* in the thing described in the reference . . . . Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" M.P.E.P. § 2112 (IV) (citing *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)). Based on the teachings of the specification and on Dr. Nagamoto's Declaration, a "method for accelerating salivation" or a "method for treatment of xerostomia" is not necessarily present in the teachings of Urashima.

First, the specification teaches that the carbostyril compound recited in claims 16 and 17, also known as Rebamipide, stimulates the muscarine M3 receptor very weakly. *See* specification, p. 13, lines 9-17. Because of the lack of stimulation at the muscarine

M3 receptor, oral administration results in "more potent effects for acceleration of salivation or . . . treatment of xerostomia in comparison with the effects for promoting secretion in the lacrimal gland." *Id.* In the attached Declaration, Dr. Nagamoto describes an experiment in which Rebamipide was tested for stimulation of the muscarine M3 receptor in comparison to PBS (a negative control) and acetylocholine and pilocarpine (two positive controls). *See* Declaration, p. 2 and 3. Consistent with the teachings of the specification, Dr. Nagamoto found that Rebamipide did not stimulate the muscarine M3 receptor. *See* Declaration, Tables 1 and 2 at pp. 3 and 4. Thus, based on the specification and Dr. Nagamoto's declaration, one of ordinary skill in the art would expect that oral administration of Rebamipide to treat dry eye would not work well, if at all. Indeed, the second experiment discussed in the Declaration demonstrates this directly.

In Experiment 2, discussed at pages 5 and 6 of the Declaration, Rebamipide was administered to rats in a dose of 30 mg/kg or 100 mg/kg. Negative control rats received just the carrier without Rebamipide added. At two hours and four hours post-administration, the tear volumes from both eyes of each rat were measured. As shown in Table 3, tear production did not differ significantly between Rebamipide treated and control rats. As Dr. Nagamoto observed, "when . . . rebamipide was orally administered to rats, the tear volume was almost the same as in the control rats administered with the vehicle." Declaration, p. 6. From this data, Dr. Nagamoto concluded that "the compound of the present invention [Rebamipide] is not effective for tear secretion by oral administration." *Id.* at 7.

Notably, none of the Examples in Urashima teach oral administration of their compositions. If one of ordinary skill in the art had tried to follow Urashima's general

teaching on oral administration of their compositions to treat dry eye in patients with Sjogren's syndrome, such treatment would not have been successful according to Dr. Nagamoto's Declaration. Given that Urashima is silent on the use of its compositions to accelerate salivation, as the Office admits, and that the oral administration suggested by Urashima for treatment of dry eye is not effective, this reference cannot possibly inherently anticipate claims 13, 14, 16, and 17.

For at least the reasons provided above, Applicants contend that claims 13, 14, 16, and 17 are not anticipated expressly or inherently by Urashima. Applicants therefore request that the Office withdraw this rejection.

Conclusions

Applicants respectfully request that the Office enter this Reply under 37 C.F.R. § 1.116 to place claims 13, 14, 16, and 17 in condition for allowance. Because Applicants have not amended the claims, this Reply does not raise new issues or necessitate the undertaking of any additional search of the art by the Office. Therefore, this Amendment should allow for immediate action by the Office.

Furthermore, Applicants respectfully point out that the final action by the Office presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Reply would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the Reply would place the application in better form for appeal, should the Office dispute the patentability of the pending claims.

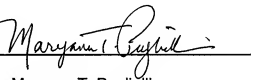
In view of the foregoing remarks, the claimed invention is not anticipated based on the prior art reference cited against this application. Applicants therefore request the entry of this Reply, the Office's reconsideration and reexamination of the application, and the timely allowance of claims 13, 14, 16, and 17.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 15, 2009

By: 

Maryann T. Puglielli
Reg. No. 52,138
(202) 408-6054